

## **REMARKS**

In the Office Action mailed November 23, 2004, the Examiner objected to the specification; objected to the drawings; rejected claims 1-6, 9-10, 12, 14-24, 27-28, 30, and 30-32 under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent Application Publication 2003/0035548 A1 (“the ’548 publication”) in view of *Cooper et al.* (U.S. Patent Application Publication 2002/0029350 A1); and rejected claims 7, 8, 11, 13, 25, 26, 29, and 31 in view of the ’548 publication and *Cooper et al.* in further view of *Okumura et al.* (U.S. Patent No. 6,553,493). The ’548 publication is a published U.S. Patent application serial No. 09/931,004, which corresponds to the instant application.

Based on the following remarks, Applicant respectfully traverses the objection to the drawings and the rejection of claims 1-33 under U.S.C. §103(a).

### **I. The Objection to the Specification**

The Examiner asserts that the “last sentence of [the] 23<sup>rd</sup> Paragraph is incomplete which is ended with “with the.” Upon review of Applicant’s copy of the application filed on August 17, 2001 with the U.S. Patent & Trademark Office, Applicant cannot find the alleged error noted by the Examiner. Indeed the paragraph starting on line 16 of page 8 of Applicant’s specification ends with “with the CA.” This paragraph corresponds to paragraph [0023] of the ’548 publication, which does end in an incomplete sentence. The U.S. Patent & Trademark Office printing of this application introduced the error that the Examiner refers to but the application as filed

has no error. Accordingly, it appears the Examiner refers to paragraph [0023] of the '548 publication to object to Applicant's specification, which as noted above, contains no such error. To avoid any further confusion, and to correct an unrelated typographical error, Applicant amends paragraph starting on line 16 of page 8 of the as-filed application to address the Examiner's concerns with the published application. As such, Applicant requests that the objection to the specification be withdrawn.

## **II. The Objection to the Drawings**

The Examiner asserts that Fig. 2 "should be designated by a legend such as -- Prior Art -- because only that which is old is illustrated." Applicant disagrees with the Examiner's position. Applicant has made no representation that Fig. 2, or its description in Applicant's specification, is prior art, as asserted by the Examiner. Indeed, Fig. 2 is described in Applicant's "Detailed Description" and includes features that are functionally part of the description of certain aspects related to Applicant's invention. For example, the description of Figs. 3 and 4A-4C include features associated with Fig. 2 (e.g., user 202, client 204, registration manager 206, certificate authority 208, certification manager 210, and data recovery manager 212). As such, Applicant respectfully traverses the Examiner's assertion that Fig. 2 illustrates only that which is old and requests the Examiner withdrawn the objection to the drawings.

### **III. The Rejections under 35 U.S.C. § 103(a)**

#### **1. Fig. 2 of the '548 Publication is not Prior Art**

To establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02. Moreover, each of these requirements must “be found in the prior art, and not based on applicant’s disclosure.” M.P.E.P. § 2143.

To qualify as prior art under 35 U.S.C. § 103(a), a reference must meet the requirements for prior art under 35 U.S.C. § 102. As noted above, the '548 publication is the published application corresponding to Applicant’s application filed August 17, 2001. As explained above, Applicant has made no representation that Fig. 2 of this application is prior art. Instead, Fig. 2 includes features that are a functional part of certain aspects related to Applicant’s invention. Accordingly, Fig. 2 of the '548 publication is not considered prior art under 35 U.S.C. § 102, and therefore, fails to qualify as prior art under 35 U.S.C. § 103(a). In light of the foregoing, Applicant requests the rejection of claims 1-33 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

2. The Rejection of Claims 1-6, 9, 10, 12, 14-24, 27, 28, 30, 32, and 33 under 35 U.S.C. § 103(a)

In addition to Applicant's position regarding the '548 publication stated above, Applicant traverses the rejection of claim 1 in view of the '548 publication and *Cooper et al.* In an attempt to reject claim 1, the Examiner asserts "AAP as modified teaches . . . receiving an indication of proof of archival of the user's encryption key associated with the request . . . . (See addressed above - Besides, an indication message is commonly used between two software entities in the field)." (*Office Action*, page 4, lines 11-18.) Applicant disagrees with the Examiner's position for the following reasons.

First, the Examiner's comment, "See Addressed above," suggests that the Examiner previously addressed the step of "receiving an indication of proof of archival." This, however, is not the case. The Examiner does not address an "indication of proof of archival of the user's encryption key" in the rejection to claim 1, or any other claim, in the Office Action. Instead, the Examiner merely states, "

Cooper teaches archiving an encryption key outside of the certificate authority (Cooper: see for example, Paragraph [0204] Line 7, Figure 3 Element 24-0, 26- & 270, and Paragraph [0005], [0052]: Cooper teach (a) the encryption keys are stored and archived by a neu[t]ral third party, and (b) the consultation module comprises an archiving capability provided by an archive module where a list of consultants can be selected under the choice of the client (Cooper: see for example, Paragraph [0146] and Claim 7- 6<sup>th</sup> & 7<sup>th</sup> Paragraphs). Therefore, the consultant database module as taught by Cooper in Figure 3, Element 260 which is directly interfaced with the client is qualified as the registration module as taught by AAP.

(*Office Action*, page 3, line 18 to page 4, line 3.) As demonstrated, the Examiner did not address an “indication of proof of archival,” as alleged in the comment “See addressed above.”

Second, the Examiner’s position that “an indication message is commonly used between two software entities in the field,” does not address an “indication of proof of archival of the user’s encryption key,” as recited in claim 1. Whether or not indication messages are used between “software entities” does not adequately address the recitations of claim 1, but instead merely represents an opinion of the Examiner that is unsupported by prior art. Indeed, the Examiner has yet to provide any evidence that the prior art teaches or suggests “receiving an indication of proof of archival of the user’s encryption key associated with a request for a digital certificate, as recited in claim 1.

Further, *Cooper et al.* does not teach or suggest this feature. Instead, *Cooper et al.* describes a system for providing secure communications in a network that includes digital certificates. While *Cooper et al.* describes an encryption key escrow facility that stores keys for subsequent access by a proper authority, the reference does not teach or even suggest providing an indication of proof of archival of a user’s encryption key associated with a request for a digital certificate. Instead, *Cooper et al.* merely discusses archiving certificates associated with, for example, streaming video segments without reference to providing proof of certificate archival.

Accordingly, the references that the Examiner can legitimately rely upon do not support the rejection. Based on the foregoing, Applicant requests that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn, and the claim allowed.

Claims 2-6 and 9 depend from claim 1. As explained, the cited art does not support the rejection of claim 1. Accordingly, the cited art does not support the rejections of claims 2-9 for at least the same reasons set forth above in connection with claim 1. As such, Applicant requests that the rejection of these claims be withdrawn and the claims allowed.

Further, the Examiner asserts that *Cooper et al.* teaches sending a request for a digital certificate, "the request having an indication of proof of archival of an encryption key for the user." (*Office Action*, page 6, lines 3-8.) Applicant disagrees. As explained above in connection with Applicant's response to the rejection of claim 1, *Cooper et al.* does not teach or suggest any indications of archival of an encryption key. Instead, the reference merely discusses an encryption key escrow that stores keys for subsequent use without disclosing indications of proof of the keys being stored. Additionally, *Cooper et al.* fails to teach or suggest a request for a digital certificate including such an indication. To address this feature, the Examiner merely states, "the encryption keys can be generated by the archive module in the consultation database module where the consultant is selected by the client." (*Office Action*, page 6, lines 5-8.) This discussion of *Cooper et al.* is in no way related to a request for a digital certificate having an indication of proof of archival of an encryption key for the user, as recited in claim 10. Additionally, as discussed above in connection with claim 1, the Examiner's comment that "an indication message is commonly used between two software entities in the field," does not address an indication of proof of archival of an encryption key, much less a request for a digital certificate having the indication, as recited in claim 10.

Accordingly, because the cited art does not support the rejection of claim 10, and Applicant requests that the rejection of this claim under 35 U.S.C. § 103(a) be withdrawn and the claim allowed.

The Examiner rejects claims 12, 15, 17, 19, 30, and 33 for the same reasons set forth in claim 1. (See *Office Action*, p[age 3, line 13 and page 10, lines 18-19.]) As such, Applicant submits the cited art does not support the rejections of claims 12, 15, 17, 19, 30, and 33 for at least the same reasons set forth in connection with claim 1 and requests that the rejection of these claims be withdrawn and the claims allowed.

Claim 14 depends from claim 12. Claims 20-27 depend from claim 19. As explained, the cited art does not support the rejections of claims 12 and 19. Accordingly, the cited art does not support the rejections of claims 14 and 20-27 for at least the same reasons set forth above in connection with claims 12 and 19. As such, Applicant requests that the rejection of claims 12 and 20-27 be withdrawn and the claims allowed.

The Examiner rejects claims 16 and 28 for the same reasons set forth in claim 10. (See *Office Action*, page 4, lines 19-21.) As such, Applicant submits the cited art does not teach or suggest the recitations of claims 16 and 28 for at least the same reasons set forth in connection with claim 10 and requests that the rejection of these claims be withdrawn and the claims allowed.

Additionally, the Examiner asserts that *Cooper et al.* teaches a “registration manager,” but does not address the manager being configured to receive an indication of proof of archival, as recited in claim 18. Indeed, the Examiner

completely ignores this recitation in rejecting claim 18. Further, the Examiner asserts that *Cooper et al.* teaches a certificate authority that “**should** confirm an indication of proof of archival was received before issuing a digital certificate.” (Emphasis Added) (*Office Action*, page 8, lines 17-18.) Whether the Examiner determines an element within *Cooper et al.* should or should not perform or include a feature recited in claim 18 does not meet the requirements for establishing a *prima facie* case of obviousness. As noted above, the references themselves must teach or suggest the recitations of a claim. In this case, the Examiner has not provided proof that *Cooper et al.*, or any other reference, teaches or suggests a digital certificate authority that issues a certificate when it determines that an indication of proof or archival was received. Instead, the Examiner concludes that such a feature “should” be performed, without providing support from a prior art reference. Indeed, *Cooper et al.* does not provide such support. As such, because the cited art does not support the rejection of claim 18, Applicant requests that the rejection of this claim be withdrawn and the claim allowed.

Applicant notes that the Examiner rejects claim 32 under 35 U.S.C. § 103(a) in view of the '548 publication and *Cooper et al.* (*Office Action*, page 10, lines 7-17.) Claim 32 depends from claim 31, which the Examiner rejects under 35 U.S.C. § 103(a) in view of the '548 publication and *Cooper et al.* and *Okumura et al.* As such, the rejection of claim 32 is improper as claim 33 is rejected under a different basis than claim 32, i.e., in view of the '548 publication and *Cooper et al.* and *Okumura et al.* Nonetheless, Applicant asserts that the cited art, in any combination, does not teach or suggest at least archiving an encryption key under



control of a user, as recited in claim 32. Indeed, none of the cited art discusses user control of any key archival. As such, Applicant requests the rejection of claim 32 be withdrawn and the claim allowed.

**3. The Rejection of Claims 7, 8, 11, 13, 25, 26, 29, and 31 under 35 U.S.C. § 103(a)**

In rejecting claims 7, 11, 13, 25, 29, and 31, the Examiner asserts "AAP as modified teaches the claimed invention as described above (see claim 1, 10, 12, 19, 28 and 30 respectively)." (*Office Action*, page 11, lines 6-7.) The Examiner, however, admits the '548 publication "does not teach the indication of proof of archival is digitally signed." (*Office Action*, page 12, lines 1-2.) To make up for this deficiency, the Examiner alleges *Okumura et al.* teaches an indication of proof of archival that is digitally signed in column 4, lines 19-32. Applicant disagrees with the Examiner's interpretation of *Okumura et al.* As noted by the Examiner, *Okumura et al.* discusses a private key that is used to digitally sign a digital message. (*Okumura et al.*, col. 4, lines 19-21.) This encryption process, however, is not the same as digitally signing an indication of proof of archival of a user's encryption key, as recited in claims 7, 11, 13, 25, 29, and 31. Indeed, *Okumura et al.* does not even suggest archiving an encryption key, much less digitally signing an indication of such archival. And as explained above in connection with claim 1, *Cooper et al.* does not teach or suggest an indication of proof of such archival. Accordingly, this reference also fails to support the Examiner's rejection. Because the cited art does not support the rejections of claims 7, 11, 13, 25, 29, and 31, Applicant requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claims 8 and 26 depend from claims 7 and 25, respectively. As explained, the cited art does not teach or suggest the recitations of claims 7 and 25. Accordingly, the cited art does not teach or suggest the recitations of claims 8 and 26 for at least the same reasons set forth above in connection with claims 7 and 25. As such, Applicant requests that the rejection of claims 8 and 26 be withdrawn and the claims allowed.

#### **IV. Conclusion**

In view of the foregoing remarks, Applicant submits that this claimed invention, is neither anticipated nor rendered obvious in view of the cited art. Applicant therefore requests the Examiner's reconsideration and reexamination of the application and the timely allowance of claims 1-33.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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